



Initial Review

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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GROUP 1500

In re Application of

SCHADE et al.

Serial No. 08/325,219

Filed: October 21, 1994

For: USE OF COPOLYMERS OF
CARBOXYLIC ACIDS AND
LONG-CHAIN COMPOUNDS WITH
ISOLATED C-C MULTIPLE BONDS
AS THICKENERS OR DISPERSANTS

Group Art Unit: 1509

Examiner: Cheng

H/17

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Honorable Commissioner of
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Washington, D.C. 20231

SUPPLEMENTAL REPLY BRIEF

Sir:

In accordance with the provisions of 37 CFR 1.193(b) and MPEP 10208.03, appellants submit herewith their Supplemental Reply Brief, which is directed only to : (a) the new ground of rejection expressly stated by the examiner in the Supplemental Examiner's Answer mailed on July 10, 1997; and (b) a new point of argument which was first raised by the examiner in the aforementioned Supplemental Examiner's Answer.

NEW GROUND OF REJECTION

Claims 10 and 15, as well as claims 11-14 and 17 which are dependent upon claims 10 and 15, have been newly rejected under 35 USC 112, second paragraph, as being indefinite. In particular, the examiner points to the language "from the group comprising", which is found in both claim 10 and claim 15, and asserts that such language renders the recited Markush groups improper, because they are not appropriately closed.

APPELLANT'S RESPONSE

By the accompanying Amendment Under 37 CFR 1.116, appellants have corrected this language in claims 10 and 15, so that the recited Markush groups are now appropriately closed and therefore proper. This amendment, which is made to accompany the instant Supplemental Reply Brief in accordance with the last sentence of 37 CFR 1.193(b) and the last paragraph of MPEP 1208.03, has therefore obviated the examiner's new ground of rejection. Accordingly, appellants submit that the new ground of rejection which was presented in the Supplemental Examiner's Answer should be withdrawn.

NEW POINT OF ARGUMENT

A single new point of argument was raised by the examiner in the aforementioned Supplemental Examiner's Answer. Therein the examiner stated on page 1 under numbered paragraph 1: "In any event, applicants have not shown that the claimed polymers have unexpected properties as compared with the broader class of polymers of George from which the claimed polymers are selected."

APPELLANT'S ARGUMENT

First of all, neither appellants nor any skilled artisan faced with the problem before appellants would have selected their polymeric materials from the polymeric materials disclosed in the George reference, as the examiner now implies. Otherwise said, one of skill in this art, when faced with the problem of producing a hydrophobic thickener, would not look to George's hydrophilic, water absorbing materials for the purpose of making a selection therefrom. It is well established in the determination of obviousness/nonobviousness under 35 USC 103 that a reference which does not treat the same problem as that facing an applicant for patent can hardly be found to suggest the solution to that problem.

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Hodosh v. Block Drug Co., 229 USPQ 182 (Fed. Cir. 1986).

Furthermore, there is no motivation for one of skill in this art to take what is actually disclosed in the George reference (where enhanced hydrophilic properties such as demand absorbency are vital to a success which is based on tendency to absorb water) and modify it to become what appellants have invented and claimed (viz. polymeric materials whose enhanced hydrophobic properties -- i.e., being antagonistic to water and resisting association with water -- have resulted in a thickening and dispersing action which is retained under strongly hydrolytic conditions), unless in retrospect and in view of appellants' claimed invention. This is not the test for obviousness under 35 USC 103. Loctite Corp. v. Ultraseal Ltd., 228 USPQ 90 (Fed. Cir. 1985). Moreover, the record must show true evidence of motivation, not merely a speculation thereof, i.e., that one of skill would have been motivated to make the modifications necessary to arrive at the claimed invention. In re Jones, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992).

Finally, in response to the examiner's statement first made here that "...applicants have not shown that the claimed polymers have unexpected properties as compared with the broader class of polymers of George...", appellants point out that because the examiner has not presented a *prima facie* case of obviousness against the instant claims, no commensurate showing of unexpected results or properties over the broad class of polymers disclosed in George is required. Indeed, the burden to rebut a rejection of obviousness with a showing (of unexpected properties) does not arise until a *prima facie* case has been established. In re Rijckaert, 28 USPQ.2d 1955, 1957 (Fed. Cir. 1993).


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Respectfully submitted,

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